REMARKS / ARGUMENT

A. INTRODUCTION

In the Office Action dated June 14, 2004, claims 1-57 were divided into four different
"inventions" of combinations and subcombinations and subjected to an election/restriction
requirement. The four identified inventions are:

> Invention I: claims 1-30;
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> Invention II: claims 31, 33, 46 and 48;
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> Invention III: claims 32, 34, 47 and 49; and
>
> Invention IV: claims 35, 40, 50-53 and 54-57.

B. NECESSARY SHOWING FOR ELECTION/RESTRICTION

To support an election/restriction, Examiner is required to establish a prima facie case showing
the inventions are independent or distinct (MPEP § 803). To show the identified inventions are
independent, the inventions must be "unconnected in design, operation, or effect" without a
disclosed relationship between them (MPEP § 802.01). In the case of combinations and
subcombinations, two inventions are distinct if (1) the combination as claimed does not require
the particulars of the subcombination as claimed for patentability, and (2) the subcombinations
has utility by itself or in other combinations (MPEP § 806.05(c)). The Examiner must further
establish that the search of the application would impose a serious burden. "If the search and
examination of an entire application can be made without serious burden, the examiner must
examine it on the merits, even though it includes claims to independent or distinct inventions"
(MPEP § 803). In the absence of a prima facie showing, the election/restriction should be
withdrawn.

(1) No Showing of Distinct Inventions

Applicant respectfully asserts that a prima facie case establishing inventions I, II, III and IV are
distinct has not been shown because the test for determining whether inventions are distinct was
misapplied in the Office Action of June 14, 2004. Examiner attempted to apply the utility portion
of the test twice and disregarded the first prong of the test requiring a showing that the
combination as claimed "does not require the particulars of the subcombination as claimed for
patentability." See MPEP § 806.05(c). Showing invention I and invention II have separate

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utilities is not the same as showing that a combination does not require the particulars of a subcombination. *That is, a combination may still have a separate utility from a subcombination but still require the particulars of the subcombination as claimed for patentability.* Therefore, Applicant respectfully asserts the application of the utilities portion of the distinct test to both prongs of the distinctness test is in error and the election/restriction improper.

<u>Examiner failed to establish inventions I and II are distinct</u>: Applicant respectfully asserts that Examiner did not establish inventions I and II are distinct because the test for distinctness was misapplied. For example, Examiner states that inventions I and II have separate utilities because invention I includes "processing for generic control systems" and invention II includes "classifying, performing and traversing on spanning tree classification." Examiner however, does not prove the invention I does not requires the particulars of invention II. For the foregoing reasons, Applicant respectfully asserts a prima facie case that inventions I and II are distinct has not been established.

<u>Examiner did not prove inventions I and III are distinct</u>: Applicant respectfully asserts that Examiner did not prove inventions I and III are distinct because the test for distinctness was misapplied. For example, Examiner states that inventions I and III have separate utilities because invention I includes "processing for generic control systems" and invention III includes "extracting, storing, retrieving and generating the address header for routing packets," but does not prove invention I does not require the particulars of invention III. Therefore, Applicant respectfully asserts that a prima facie case that inventions I and III are distinct has not been established.

<u>Examiner did not prove inventions I and IV are distinct</u>: Applicant respectfully asserts that Examiner did not prove inventions I and IV are distinct because the test for distinctness was misapplied. For example, Examiner states that inventions I and IV have separate utilities because invention I includes "processing for generic control systems" and invention IV includes "providing the disposition decision for the packet." Examiner however, does not prove the invention I does not requires the particulars of invention IV. For the foregoing reasons, Applicant

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respectfully asserts that a prima facie case that inventions I and IV are distinct has not been established.

<u>Examiner did not prove inventions II and III are distinct</u>: Applicant respectfully asserts that Examiner did not prove inventions II and III are distinct because the test for distinctness was misapplied. For example, Examiner states that inventions II and III have separate utilities because invention II includes "classifying, performing and traversing on spanning tree classification" and invention III includes "extracting, storing, retrieving and generating the address header for routing packets," but does not prove invention II does not require the particulars of invention III. Therefore, Applicant respectfully asserts that a prima facie case that inventions II and III are distinct has not been established.

<u>Examiner did not prove inventions II and IV are distinct</u>: Applicant respectfully asserts that Examiner did not prove inventions II and IV are distinct because the test for distinctness was misapplied. For example, Examiner states that inventions II and IV have separate utilities because invention II includes "classifying, performing and traversing on spanning tree classification" and invention IV includes "providing the disposition decision for the packet." Examiner however, does not prove invention II does not requires the particulars of invention IV. For the foregoing reasons, Applicant respectfully asserts that a prima facie case that inventions II and IV are distinct has not been established.

<u>Examiner did not prove inventions III and IV are distinct</u>: Applicant respectfully asserts that Examiner did not prove inventions III and IV are distinct because test for distinctness was misapplied. For example, Examiner states that inventions III and IV have separate utilities because invention III includes "extracting, storing, retrieving and generating the address header for routing packets" and invention IV includes "providing the disposition decision for the packet," but does not prove invention III does not require the particulars of invention IV. Therefore, Applicant respectfully asserts that a prima facie case that inventions III and IV are distinct has not been established.

(2) No Showing of Undue Burden

Applicant respectfully asserts Examiner failed to show it would be an undue burden to search the entire application without the election/restriction. "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (MPEP § 803). While Examiner did attempt to separate the different inventions into separate classification groups, Examiner failed to provide an explanation as to why this search would be burdensome and absent this explanation Applicant respectfully requests Examiner withdraw the election/restriction.

C. RESTRICTION IS IMPROPER

Despite the fact there was no showing of the inventions being distinct, Applicant respectfully asserts the inventions are not independent. In order for inventions to be independent the inventions must be "unconnected in design, operation, or effect" without a disclosed relationship between them (MPEP § 802.01).

(1) Inventions I and II Are Not Independent

Applicant respectfully asserts the combinations and subcombinations embodied in Invention I and invention II are connected in design, operation, and effect and are therefore not independent. For example, invention I is a packet switching controller (claim 1) comprising a packet classification engine in the preferred embodiment (page 6, line 12; FIG. 1), and invention II is a packet classification engine (claim 31) comprising a particular type of packet classification engine that performs, for example, classification and spanning tree processing (page 17, lines 21-23; 26-28). Since invention I contains a packet classification engine in the preferred embodiment and invention II uses a packet classification engine to perform packet classification, the two inventions are connected in design and operation and therefore are not independent.

(2) Inventions I and III Are Not Independent

In addition, invention I and invention III are not independent of one another. Invention III is a packet classification engine (claim 32) comprising a particular type of packet classification engine that performs the steps of, for example, extracting and storing address headers for routing packets (page 16, line 29-31). Since invention I contains a packet classification engine in the

preferred embodiment and invention III uses a packet classification engine to perform the method of data extraction, inventions I and III are connected in design and operation and therefore are not independent.

<div align="center">(3) Inventions I and IV Are Not Independent</div>

Applicant respectfully asserts invention I and invention IV are not independent of one another. For example, invention I in the preferred embodiment is a packet switching controller (claim 1) comprising an application engine (page 7, line 1; FIG. 1), and invention IV is a packet switching controller (claim 35) comprising a particular type of application engine that performs, for example, disposition decisions for the packet (page 21, line 2; FIG. 7). Since invention I contains an application engine in the preferred embodiment and invention IV uses an application engine to perform the disposition decisions for the packet, inventions I and IV are connected in design and operation and therefore are not independent.

D. ELECTION OF THE INVENTION

Should Examiner decline to withdraw the election/restriction requirement in light of the reasons stated above, Applicant elects *invention I* to be examined and is therefore fully responsive to the office action dated June 14, 2004.

E. CONCLUSION

Should there be any fees for this action, your office is authorized to draw from the firm deposit account number 02-3979. Should you have any questions, or identify any problem, I would appreciate a telephone call so that this matter may be resolved promptly.

Respectfully submitted,
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